

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Hearing:
May 29, 2003

Paper No. 97

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Duke University
v.
Haggar Clothing Co.

Opposition No. 108,304
to application Serial No. 75/113,735
filed on June 4, 1996

Susan Freya Olive of Olive & Olive, P.A. for Duke
University.

Priscilla L. Dunckel of Baker Botts LLP for Haggar Clothing
Co.

Before Cissel, Quinn and Walters, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On June 4, 1996, applicant filed the above-referenced application to register the mark "DUKE AMERICA" on the Principal Register for "wearing apparel, namely, men's and boys (sic) pants, jeans, shorts, belts, shirts, suits, jackets, coats, vests, sweaters, neckties, swimwear, socks, underwear and hats," in Class 25. The stated basis for filing the application was applicant's assertion that it possessed a bona fide intention to use the mark in commerce

in connection with the goods listed in the application. The application was examined and the mark was passed to publication with a disclaimer of the geographically descriptive word "AMERICA."

A timely Notice of Opposition was filed by Duke University on November 7, 1997. As grounds for opposition, opposer alleged that "DUKE AMERICA" so resembles opposer's famous "DUKE" marks, which have been used in connection with identical goods, that if it were used in connection with the clothing items listed in the application, confusion or mistake would be likely. In its answer, applicant denied the essential allegations set forth in the Notice of Opposition.

A trial was conducted in accordance with the Trademark Rules of Practice. Much of the results of the discovery conducted by the parties was made of record, either by notices of reliance or as exhibits to testimonial depositions. In addition to documentary and written discovery, each party took the deposition of a designated representative of the other. During the trial, Duke deposed fourteen individuals and filed a Notice of Reliance on eighty items, including the discovery deposition, with exhibits, of Alan Burks, applicant's Vice President. During its own testimony period, applicant also took the testimony of Mr. Burks, as well as the testimony of employees of three

third parties, Royal Textile Mills, Inc., Haband Company and the James Madison University Foundation, Inc..

On the last day of applicant's testimony period, applicant filed a notice of reliance on thirty-seven additional items, including the affidavit, with exhibits, of a paralegal employee of counsel for applicant. Opposer objected to the Board's consideration of this affidavit and the exhibits to it. Although applicant subsequently asked opposer to consent to the introduction of this testimony and exhibits, opposer did not consent. In view of this fact, we have not considered it. See Trademark Rule 2.123(b). Accordingly, opposer's objection to the affidavit and its exhibits is sustained.

The other matter that requires explanation prior to our discussion of the determination of this opposition on its merits is applicant's objection to our consideration of the testimony of opposer's expert witness, Mr. McBride, and to the survey he conducted. Opposer presented this testimony and evidence (as well as two other depositions to which applicant has not objected) as rebuttal, i.e., after opposer had presented its case in chief during its testimony period, and after applicant had responded to opposer's claims and evidence during applicant's testimony period. Resolution of applicant's timely made objection was properly deferred until final decision, as the parties were advised at the

time applicant first objected to Mr. McBride's testimony and the survey upon which it is based, and applicant and opposer both argued this issue in their respective briefs and at the oral hearing.

The issue is whether opposer's survey and the testimony that explains it were proper rebuttal as responsive to applicant's asserted defenses, or, as applicant asserts, this testimony and these exhibits could only have been presented as part of opposer's case in chief.

The survey was designed to determine whether the third-party uses shown by applicant during its testimony period have diluted the fame of opposer's "DUKE" mark for clothing, and whether, as applicant argues its testimony and evidence shows, such third-party uses of similar marks have created a marketplace in which confusion between opposer's mark and the mark applicant seeks to register would not be likely.

The survey employed standard mall intercept methodology. It was conducted at locations outside North Carolina, where opposer's main campus is located, and away from other schools in opposer's athletic league. One of the sites was in applicant's home state of Texas. Others were spread across the country, from Florida to California, including locations in Arizona, Massachusetts, Ohio and Minnesota.

Qualified respondents were shown an ordinary t-shirt of the type actually sold by Duke University, bearing either the mark "DUKE" or the mark "DUKE AMERICA." Respondents were asked questions about the shirt they were shown. First they were asked what came to mind when they saw the name on the shirt. Then they were asked whether they thought it was likely that the shirt was endorsed by or associated with the entity that they had identified responsive to the first question. Additionally, the surveyor asked the respondents why they had answered the way they did.

Opposer contends that the survey disproves applicant's contention that the strength of opposer's mark has been diluted by third-party uses of similar marks. Almost three quarters of the qualified respondents associated opposer with the shirt bearing the "DUKE" mark, and 84 percent of those people believed the university either endorsed or was associated with these shirts. Significantly, almost two-thirds of the respondents associated opposer with the shirts bearing the "DUKE AMERICA" mark, and 71 percent of those people thought the university had endorsed or was associated with them. Based on the results of this survey, opposer contends that in spite of the purported diluting effects of the third-party uses demonstrated by applicant, opposer's "DUKE" mark is strongly associated with opposer, and a large portion of the potential purchasers of applicant's shirts

would assume that the mark applicant seeks to register, "DUKE AMERICA," would indicate that the shirts were endorsed by or associated with opposer. Significantly, none of the businesses shown by applicant to be using marks consisting of or including "DUKE" were identified by participants in connection with either the "DUKE" or the "DUKE AMERICA" branded shirts. Other than opposer, no entity achieved statistically significant recognition in this regard.

There is no question that Mr. McBride's testimony and the survey he conducted would have been appropriate to present as part of opposer's case in chief. Neither party contests this fact. Applicant argues that once opposer failed to conduct and introduce the survey during its testimony period, however, opposer could not thereafter introduce it. Applicant argues that because the survey goes directly to the issue of whether applicant's mark is likely to cause confusion with opposer's mark, the only appropriate time for the survey to be introduced was during opposer's testimony period, and that if opposer is allowed to get the survey and accompanying testimony into the record after applicant had responded to opposer's claims and supporting testimony and evidence, applicant would effectively be precluded from responding to the survey with evidence and testimony from its own expert. In this regard, applicant contends that it was not even given enough notice and

information about the survey to prepare properly for Mr. McBride's deposition.

After careful consideration of the arguments of both parties, we have decided to consider this testimony and evidence because it is proper rebuttal under the circumstances presented by this case. During its initial testimony period, opposer had the burden of establishing its standing; of establishing its ownership of the marks with which it contends applicant's mark would be likely to cause confusion; of establishing use of these marks before applicant filed the application to register the mark it seeks to register; and of establishing a prima facie case of likelihood of confusion based on the similarity of the marks and the relationship between opposer's goods and the goods with which applicant intends to use the mark it seeks to register.

As discussed below, opposer met this burden of proof, but, as opposer points out, opposer was not required to anticipate or guess what grounds of defense might be raised by applicant, or to counter those grounds of defense prior to their assertion. Dilution was not raised by applicant as a defense in its answer to the Notice of Opposition. When applicant presented testimony concerning the alleged dilution of opposer's marks, opposer properly rebutted the dilution defense asserted by applicant with three

depositions, one of which is the deposition of Mr. McBride to which applicant objects. Under these circumstances, his testimony and the exhibits to it are admissible as rebuttal testimony.

Applicant's assertion that it was denied the opportunity to cross-examine the witness effectively is also not well taken. As the record shows, opposer fully complied with applicant's discovery requests, as well as with the agreement between applicant and opposer that opposer would not introduce at Mr. McBride's deposition any documents containing new information beyond that contained in documents provided by opposer to applicant prior to the deposition. This record shows that applicant had fair notice of and adequate time to prepare for Mr. McBride's deposition, and that applicant was given in advance the information it needed to cross-examine the witness effectively.

Applicant's substantive criticisms of the survey evidence presented by opposer are not well taken either. For example, applicant argues that the survey was unfair because the shirts on which the marks were shown to the survey respondents were identical to shirts on which opposer's mark is actually used. Applicant expressed outrage at this fact and concluded that it should come as no surprise that respondents were confused when applicant's

mark was used on opposer's goods. This argument conveniently overlooks the fact that as identified in the application, applicant's goods encompass the goods on which opposer has used its mark. Applicant's other objections to the survey and to Mr. McBride's status as an unbiased expert witness are similarly without merit. Because applicant shows its mark in typed format in the application, applicant would be free to adopt any style of lettering it chooses, so the fact that the shirts used in the survey present the marks in block letters does not invalidate the results of the survey. Similarly, in view of the absence in the application of restrictions or limitations as to the types of shirts, for example, the channels of trade through which they will move, and the purchasers applicant plans to target with its advertising for its goods, opposer was under no obligation to use only high-end items of apparel or to choose only well off, sophisticated consumers for its survey.

In any event, because opposer had already met its burden of establishing that confusion would be likely if applicant were to use the mark it seeks to register in connection with the goods listed in the application, and because applicant's testimony and evidence do not overcome the prima facie case established by opposer, even if we did not consider Mr. McBride's testimony and the exhibits to it,

we would still reach the same conclusion on the merits of this proceeding.

Both applicant and opposer agree that the case of *In re E.I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), establishes the test for determining whether confusion would be likely. In that case, the Court listed the principal factors to be considered in resolving this issue. Chief among these factors are the similarity of the marks as to appearance, pronunciation, meaning and commercial impression and the similarity of the goods.

The record shows that opposer is a famous private university, which provides a top-notch education to undergraduate students as well as to post-graduate students in many fields, including medicine, business and law. Duke's intercollegiate basketball program is at least as well known as the university's academic prowess. Since 1925, the university has used the mark "DUKE" in connection with its activities, including the sale of men's and boys' pants, belts, shirts, jackets, sweaters, neckties and socks. Opposer owns a half dozen registrations for marks which include the name "DUKE," but opposer's rights in "DUKE" alone for these clothing items are common law rights based on opposer's use of the mark in commerce in connection with these products. Although opposer has not used the precise mark applicant seeks to register, opposer did sell a shirt

bearing both the word "DUKE" and the letters "U.S.A." prior to the filing date of the opposed application.

Applicant, Haggar Clothing Co., is a manufacturer of apparel. Its headquarters are in Dallas, Texas. Applicant intends to use the mark "DUKE AMERICA" on a line of high-end, relatively expensive clothing which is to include pants, jeans, shorts, belts, shirts, suits, jackets, coats, vests, sweaters, neckties, swimwear, socks, underwear and hats, all for men and boys. Applicant asserts that it selected "DUKE AMERICA" to identify a fictitious person who represents a particular lifestyle that consumers will want to emulate. Applicant's promotional plan is based around this freewheeling character, a photographer who roams the country taking pictures of interesting things.

The evidence and argument presented by applicant in this regard, however, is immaterial. Potential purchasers of applicant's goods bearing the mark sought to be registered would not necessarily be aware that the mark is supposed to be the name of this fictitious character or of the reasons applicant selected its mark, and the application does not limit or restrict the goods with regard to their cost, the channels of trade through which they will move, or the sophistication or knowledge of the purchasers of such goods. Under these circumstances, therefore, we must consider the items of clothing identified in the application

to include all types of such products, and, as opposer points out, because opposer has used its mark on "shirts," "hats" and other items of apparel, we must consider the goods with which applicant intends to use its mark to be identical to those on which opposer has used its mark.

"When marks would appear on virtually identical goods or services, the degree of similarity between the marks necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ 6098, 1700 (Fed. Cir. 1982).

Opposer has established that Duke is a famous school and that people expect schools to endorse t-shirts, which are encompassed within Haggar's identification of goods. Opposer does in fact license the use of its mark in connection with such use and also in connection with other clothing goods. The evidence of sales and promotion of apparel items under opposer's mark supports opposer's claim that its mark is famous. There is no question that if applicant were to use "DUKE" on such products, confusion would be likely.

The issue thus becomes whether the addition of the geographically descriptive, disclaimed word "AMERICA" is sufficient to avoid the likelihood of confusion. We hold that it is not. This record does not establish any basis for concluding that prospective purchasers of these clothing

items would assume that "DUKE AMERICA" is anyone's name, much less that they would necessarily be familiar with the fictitious character which will be featured in the advertising campaign that applicant plans to use in promoting its new line of clothing. To the contrary, in view of the renown of opposer's "DUKE" mark, it is likely that the addition of the word "AMERICA" would be viewed either as an indication of where the university is or as an attempt to link the university with patriotism. In either event, the primary indicator of the secondary source of t-shirts bearing the mark "DUKE AMERICA" would be the name "DUKE," which opposer has used and promoted for more than three quarters of a century.

The fame of opposer's mark has been clearly established, and it plays a significant role in our analysis of the likelihood of confusion. See: *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); *Recot, Inc. v. M. C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992); and *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). Especially in view of the fame of opposer's mark, the use of the mark applicant seeks to register would be likely to cause confusion.

As noted above, applicant argues that third-party use of opposer's mark has resulted in a marketplace which is so crowded with "DUKE" marks that purchasers readily distinguish among them. In support of its claim that the source-identifying significance of opposer's mark is diluted, during its testimony period applicant made of record evidence of the use of a number of marks consisting of or incorporating the name "DUKE" for a variety of goods and services. Although some of this evidence is irrelevant because the marks in their entireties are dissimilar or the marks consist of or incorporate "DUKES," rather than "DUKE,"¹ the evidence submitted by applicant does establish that two entities, Royal Textiles, Inc. and Haband Company, Inc., have used "DUKE" marks in connection with particular items of clothing for some time, apparently without causing any confusion. Royal Textiles has used and registered "DUKE," "LADY DUKE" and "DUKE" and a design, and has established through use rights in the mark "DUKE ATHLETIC PRODUCTS." Haband has also used the mark "DUKE" in connection with clothing items for years, apparently without causing any actual confusion.

A closer look at the goods and the channels of trade through which Royal Textiles' products have moved undercuts applicant's argument that these third-party uses of similar

¹ e.g., "Duluth-Superior Dukes," "DUKE BOYD," "DUKE KAHANAMOKU,"

marks on related goods have resulted in the dilution of opposer's famous mark. Royal Textiles, for example, does sell t-shirts, but this activity is conducted within the same channels of trade that the corporation uses for its athletic supporters and other sports equipment. All but a small percentage of such shirts are sold to athletic teams in bulk, with the team names to be printed on them by whoever purchases them. It is not surprising that the sports organizations which purchase their equipment and clothing from Royal Textiles do not view the tag bearing either the name "DUKE" or the name "DUKE ATHLETIC PRODUCTS" as an indication that Duke University has sponsored were endorsed these goods.

While applicant has established that Haband has used and promoted "DUKE" as a mark on its items of apparel for a number of years, such use by a single entity does not mandate that we must conclude that the source-identifying significance of opposer's famous mark has become diluted.

In summary, opposer has met its burden of establishing prior use of its mark; that its mark is famous, and that the mark applicant seeks to register so resembles opposer's mark that if it were to be used in connection with the goods specified in the application, which are identical to goods on which opposer has previously used its famous mark,

"THE DUKES OF HAZARD," and the James Madison University "DUKES."

confusion would be likely. Applicant's evidence of lack of distinctiveness falls short of establishing that prospective purchasers of apparel are so familiar with third-party uses of "DUKE" in connection with these goods that they would not mistakenly assume that the mark "DUKE AMERICA" is an indication that the clothing bearing it is endorsed by, or associated with, Duke University.

At the conclusion of applicant's brief, applicant quoted from Trademark Rule 2.133(b), which was promulgated to implement the amendment to Section 18 of the Act allowing a party to amend its application to reflect the realities of the commercial activity being conducted under a particular mark. Applicant cites this rule in support of its request that if the Board determines that applicant's mark is not entitled to registration in the absence of trade channel restrictions and/or limitations with respect to the customers for the goods, applicant should be allowed to make such amendments to the identification-of-goods clause in the application.

As opposer points out, applicant has not yet used the mark it seeks to register, so it has established no channels of trade and no customer base for its goods. This case was tried by the parties based on the application as filed, without any such limitations or restrictions, so the proposed amendment to the application is plainly untimely at

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this juncture. See TMBP Section 311. See also Eurostar, Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG, Spezialfabrik Fur Reitbekleidung, 43 USPQ2d 1266 (TTAB 1994) and Pegasus Petroleum Corp. v. Mobil Oil Corp., 227 USPQ 1040 (TTAB 1985). Opposer correctly took the position that the evidence offered by applicant during the trial of the market channels it intends to use and the customers it plans to target was irrelevant because the application was not limited as to channels of trade or customers. Applicant's request to amend is neither timely nor specific enough to have afforded opposer fair notice of the proposed restriction. Opposer has not consented, either explicitly or by implication, to any such amendment. Moreover, even if such an amendment were appropriate, the evidence does not support a finding that applicant's planned "DUKE AMERICA" clothing, no matter how it could be described and no matter how the clothing trade channels through which it will move could be identified, could avoid the likelihood of causing confusion with opposer's clothing bearing its famous "DUKE" mark. Accordingly, applicant's request to be allowed to amend the application is denied.

DECISION: The opposition is sustained and registration to applicant is refused.